

REMARKS

Claims 9, 11-13, 37 and 41-44 are pending in the application. Claims 9 and 37 have been amended. Reconsideration of this application is respectfully requested.

The Office Action rejects claims 9, 11-13, 37 and 41-44 under the first paragraph of 35 U.S.C. 112 as failing to comply with the written description requirement. The Examiner contends that independent claims 9 and 37 (as amended in the amendment filed August 28, 2009) recite the feature, "a first transparent conductive layer disposed directly on said first surface of said bottom substrate" as disclosed in the original specification at page 22, line 29, to page 23, line 12. However, in an amendment dated July 22, 2002, the original language, "first transparent (or non-transparent) conductive layer 82" was replaced by "thin film transistor and bus line layer (detailed structure not shown but well known in the art) 82". The Examiner concludes that due to this change, independent claims 9 and 37 contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The specification has been amended to restore the original language to the paragraph beginning at page 22, line 29. Therefore, this amended paragraph provides original written description and basis that supports the recital "a first transparent conductive layer disposed directly on said first surface of said bottom substrate" as claimed in independent claims 9 and 37. Accordingly, it is submitted that the rejection of claims 9, 11-13, 37 and 41-44 under the first paragraph of 35 U.S.C. 112 is obviated by the amendment.

The Office Action rejects claims 9, 11-13 and 37 under 35 U.S.C 103(a) as unpatentable over U.S. Patent No. 6,665,036 to Oh et al., hereafter Oh, U.S.

Patent No. 4,345, 249 to Togashi et al, hereafter Togashi, in view of U.S. Patent No. 6,111,627 to Kim et al., hereafter Kim, U.S. Patent No. 5,995,186 to Hiroshi, hereafter Hiroshi, and U.S. Patent No. 6,061,114 to Callegari et al., hereafter Callegari.

This rejection is respectfully traversed. Amended independent claims 9 and 37 each recite:

“a plurality of common electrodes and a plurality of pixel electrodes disposed in an arrangement in a plane of said bottom substrate so as to produce an electric field that is normal to said plane”.

Support for this recital is found in the paragraph beginning at page 22, line 29, of the specification and at page 23.

The combination of Oh, Togashi, Kim, Horoshi and Callegari does not disclose this recital. Togashi was added to the combination to show a transparent layer directly on the bottom substrate. However, Togashi's conductor arrangement provides an electric field in the plane of the bottom substrate and not normal to the substrate as claimed in amended independent claims 9 and 37. Therefore, the combination of Oh, Togashi, Kim, Horoshi and Caligari does not disclose this recital. Thus, independent claims 9 and 37 and dependent claims 11-13 are unobvious in view of the combination of Oh, Togashi, Kim, Horoshi and Caligari.

The Office Action suggestion to use Togashi, Kim, Horoshi and Callegari in combination with is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989).

"The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 9, 11-13 and 37 under 35 U.S.C. 103(a) is obviated by the amendment and should be withdrawn.

The Office Action rejects claims 40-44 under 35 U.S.C 103(a) as unpatentable over Oh, Togashi, Kim, Hiroshi and Callegari as applied to claims 9, 11-13, 13 and 40 and further in view of U.S. Patent No. 6,124,914 to Chaudhari et al., hereafter Chaudhari.

This rejection is moot as to claim 40, which was previously cancelled.

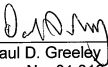
This rejection is respectfully traversed for the same reason set forth in the discussion of amended independent claims 9 and 37, from which claims 41-44 depend. That is, the combination of Oh, Togashi, Kim, Hiroshi and Callegari lacks a recital of amended independent claims 9 and 37. Chaudhari, which was cited for a different reason, does not supply the deficiency of the combination of Oh, Kim, Hiroshi and Callegari. Therefore, the combination of Oh, Togashi, Kim, Hiroshi, Callegari and Chaudhari also lacks the recital of amended independent claims 9 and 37. For the reasons set forth above, claims 41-43 are unobvious over the combination of Oh, Togashi, Kim, Hiroshi, Callegari and Chaudhari.

For the reasons set forth above, it is submitted that the rejection of claims 41-44 under 35 U.S.C. 103(a) is obviated by the amendment and should be withdrawn.

It is respectfully requested for the reasons set forth above that the rejections under 35 U.S.C. 112 and 35 U.S.C. 103(a) be withdrawn, that claims 9, 11-13, 37 and 41-44 be allowed and that this application be passed to issue.

Respectfully Submitted,

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